

REMARKS

Drawings

In item 4, the drawings are objected to for failing to show “a sensor circuit”, “a processor” and “a magnetic sensor system” in claims 1, 13 and 14; and “arcuate surfaces” in claim 5. Correction is required.

Applicant has amended claims 1, 13 and 14 by deleting any references to “a sensor circuit” and “a processor” as the already included term “portable electronic appliance” is correct. After deletion of these terms, no correction to the drawings is required.

Regarding the phrase “a magnetic sensor system”, this phrase was added to paragraph [0031] in the last filed amendment dated October 1, 2007. In addition, the “first sensor 28” which is defined as the magnetic sensor system was introduced in a Replacement Sheet drawing in the amendment filed on August 24, 2006. Accordingly, this feature has been illustrated in the drawings and no further correction is believed to be necessary.

Rejection of the Specification

In item 5, the specification is objected to because clarification is required when referencing co-pending patent application serial no. 10/158,592.

Applicant has amended the specification in paragraph [0031] as suggested by the Examiner.

In item 6, the specification is objected to because the phrase “(not shown)” was left in the amended paragraph [0031] of the amendment filed October 1, 2007.

Applicant has amended the specification in paragraph [0031] as requested by the Examiner.

Claim rejections under 35 U.S.C. § 103

Before addressing the specific obviousness rejection, Applicant wishes to clarify what is required to support an obviousness rejection. The Office Action must establish a prima facie case of obviousness to meet the burden of ' 103.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicant submits that the Office Action does not make a prima facie case of obviousness in that it does not show either (a) some objective teaching in the prior art that suggests combining the references, or (b) knowledge generally available to one of ordinary skill in the art which would lead that individual to combine the relevant teachings of the references

to achieve the invention claimed, or c) that the combined inventions would result in the claimed invention. See In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

With these requirements in mind, the specific rejections are addressed. In item 7, 1-6, 8, 14-19 and 21 are rejected as being unpatentable over Davis in view of Gay.

Regarding claims 1 and 2, it is argued that Davis teaches a portable telephone having a first sensor (motion sensor 504) and a second sensor 304 (capacitive switch).

Applicant respectfully traverses the rejection of claims 1 and 2 in light of Davis. Davis fails to teach an embodiment that combines the motion sensor and the capacitive switch. The embodiments of Davis teach various sensors, but not in combination.

The Office Action then asserts that Davis does not teach that the first sensor is magnetic, but is only a motion sensor. However, Gay is asserted to teach a magnetic sensor system.

Applicant respectfully traverses the rejection of claims 1 and 2 in light of Davis in view of Gay. Applicant can find no teaching in the references for combining the capacitive switch of Davis with the magnetic sensor system of Gay. Davis itself fails to teach that the first sensor (motion sensor) is ever combined with the second sensor (capacitive switch). The Switch Detector 546 of Davis should not be confused with a capacitive switch. Davis teaches a grasp detector such as first plate 208 and second plate 206 of figure 2, the capacitive switch 304 of figure 3, the thermal switches 406 and 408 of figure 4, and the light sensitive switch 604 of figure 6. In all embodiments of Davis, only one type of sensor is ever provided in the device. Therefore, Davis teaches away from the present invention because 1) it does not teach

combining different types of sensors in the portable electronic appliance, and 2) with the many sensors it does teach, Davis still fails to teach a magnetic sensor system which is asserted to be well known at the time of the invention of Davis. It is noted that Gay fails to teach any application of its magnetic sensor system, and therefore also fails to provide motivation for its use in combination with the device of Davis.

It is also noted that the magnetic sensor system of the present invention teaches a function that is not taught by any of the sensor systems of Davis. The present invention teaches using the magnetic sensor system to perform a function that is related to the orientation of the portable electronic appliance. In contrast, Davis fails to teach any function that is activated or used according to the orientation of the mobile telephone, but only by its movement or how it is grasped. Accordingly, Davis again fails to teach any motivation for the use of a magnetic sensor system that provides orientation information.

Regarding figures 3 and 8, it is asserted that both Davis and Gay teach the use of movements of a sensor for providing input. It is then asserted that it would have been obvious to use the magnetic sensor system as taught by Gay for the Davis motion sensor to achieve the results of detecting the movements and/or orientation of the device housing for providing inputs.

Applicant respectfully traverses the rejection of claims 3 and 8. Claims 3 and 8 claim a single or a plurality of capacitive touchpads. These sensors have nothing to do with the magnetic sensor system of Gay or the motion sensor of Davis. Furthermore, these claims are now dependent upon an arguably allowable independent claim.

Regarding claims 3-6 and 8, these claims are rejected in light of Davis.

Applicant respectfully traverses the rejection of claims 3, 4, 6 and 8 (claim 5 already being cancelled). These claims are now dependent upon an arguably allowable independent claim.

In item 9, claims 7, 9, 10, 12, 13, 20, 22, 23 and 25 are rejected as being unpatentable over Davis in view of Gay and further in view of Smith. Davis and Gay fail to teach proximity sensing, but Smith is asserted to teach proximity sensing.

Applicant respectfully traverses the rejection of claims 7, 9, 10, 12, 13, 20, 22, 23 and 25. Claim 13 is allowable for all the reasons given previously that show Davis and Gay fail to provide the motivation for combining sensor systems to create a device as taught in the present invention. Claims 7, 9, 10, 12, 20, 22, 23 and 25 are all also arguably dependent upon allowable independent claims.

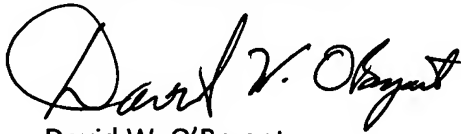
Conclusion

In light of the statements above, Applicant respectfully requests issuance of claims 1-4, 6-10, 12-23 and 25. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the examiner is invited to call David W. O'Bryant at (801) 478-0071 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

DATED this 23rd day of April, 2008.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David W. O'Bryant", written in a cursive style.

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